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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,190	06/19/2001	Thomas Gassenmeier	113486 PCT/US	7590

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 10/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,190

Applicant(s)

GASSENMEIER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.



DETAILED ACTION

Receipt is acknowledged of response filed on July 24, 2002. Claims 7-25 are pending. Claim rejections under 35 U.S.C. 112 are withdrawn in view of applicants' remarks. Claim rejections under §§ 102 and 103 are maintained for the reasons of record as indicated in the previous Office action dated April 24, 2002.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 7-9, 13, and 15 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Sun et al. (US 5993787) ("Sun").

Rejection is maintained for reasons of record as indicated in the previous Office action dated April 24, 2002. See also Response to Argument below.

2. Claims 7-10, 13, and 15 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Cowton et al. (US 6299889 B1) ("Cowton").

Rejection is maintained for reasons of record as indicated in the previous Office action dated April 24, 2002. See also Response to Argument below.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 7-10, 13-15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trinh et al. (US 5540853) ("Trinh").

Rejection is maintained for reasons of record as indicated in the previous Office action dated April 24, 2002. See also Response to Argument.

2. Claims 7-12, 15, and 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murase (US 4801331).

Rejection is maintained for reasons of record as indicated in the previous Office action dated April 24, 2002. See also Response to Argument below.

Response to Arguments

Applicant's arguments filed July 24, 2002 have been fully considered but they are not persuasive.

Applicants argue that the Sun and Cowton patents do not anticipate the instant invention because the present invention contains water and water-miscible components and is void of propylene carbonates. The arguments are not commensurate with the scope of the claims. An aqueous phase is not a claimed limitation in this case. The claimed method instead only requires a "cosmetic or pharmaceutical composition". The formula (I) in claim 1 also includes propylene carbonate when R1 is hydrogen and R2 represents a methyl group. The claimed method is necessarily practiced by topically applying the prior art compositions to skin or hair. Thus, the § 102 rejections are proper.

Applicants' argument that the Trinh reference fails to disclose propylene carbonate in aqueous phase is again not commensurate with the scope of the claims, for the claims are not limited to compositions having a water phase. The reference meets instant claims because it teaches the cyclic carbonates that are within the scope

of the claims, used in cosmetic compositions that are expected to render moisturizing properties. Nothing unexpected or nonobvious is shown in topically applying cosmetic compositions having ingredients old and well known in the art.

Regarding the obviousness rejection in over Trinh in view of Murase, applicants also argue that high level of wettability does not equate to moisturizing property. While applicants assert that a wetting agent is not necessarily a skin or hair moisturizer, examiner notes that in this case cyclic carbonates are, as evidenced by Murase, cosmetic components which are preferred over other conventional solvent for its known moisturizing effect. Given the teaching in Trinh that propylene carbonate, a cyclic carbonate, is also a conventionally used as a liquid carrier for skin or hair composition, the motivation to substitute the propylene carbonate with another cyclic carbonate, such as glycerin carbonate for obtaining similar or better result would have been obvious to the skilled artisan. Applicants' argument that the Murase patent fails to teach method of contacting a substrate with a composition containing cyclic carbonate is also unpersuasive since the reference teaches that cyclic carbonates are used in topical applications.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
September 30, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

10/1/02